Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REGIS T. KEELAN

Appeal No. 2004-0285
Application No. 08/989,320

ON BRIEF

Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10, 12, 22-24, 26, 30 and 31, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a golf putter head. An understanding of the invention can be derived from a reading of exemplary claim 10, which has been reproduced below.

Claims 10, 12, 22-24, 26, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bulla U. S. Patent No. 3,266,805, issued August 16, 1996.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 40) for the examiner's reasoning in support of the rejection, and to the Brief (Paper No. 39) and Reply Brief (Paper No. 41) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant explains that in the prior art metal was the traditional material of choice for putter heads, and attempts were made to improve upon this construction by providing an internal cavity to absorb energy from the impact of the head with the golf ball to soften the impact and cause the ball to travel slower and with more accuracy.

According to the appellant, this had the disadvantage of placing two discrete materials adjacent to one another, which caused problems due to differing coefficients of expansion, poor adhesion, and unpredictable transfer of forces at the interface of the two materials. The appellant's invention provides a composite golf club putter head wherein metal is blended into a plastic base to form a composite material, which purportedly overcomes the problems present in the prior art putters. See specification, pages 1-3.

The invention is expressed in claim 10, the sole independent claim, in the following manner:

> A putter head with a striking face, comprising:
>
> a body made from a uniformly blended composition of plastic and metal, with the metal being all powder prior to being uniformly blended with the plastic, the metal powder being between fifty and ninety-five percent by weight of the uniformly blended composition, and the striking face of the finished putter having a minimum hardness of Shore A85.

The examiner has rejected this claim under 35 U.S.C. § 103(a) as being obvious in view of the teachings of Bulla. In arriving at this conclusion the examiner has found Bulla teaches mixing metal powder with plastic, and asserts that uniform mixing of these ingredients is inherent in the disclosure. The examiner further asserts Bulla discloses that the metal filler in the club varies from 25% to as much as 75%, which overlaps the appellant's claimed range, and that one of ordinary skill in the art would have recognized that this teaching is applicable to putter heads as well as the other

clubs in a set. With regard to the Shore hardness range, the examiner has taken the position that the range has no upper limit and therefore would include virtually any putter, since Shore A85 is relatively soft in comparison to known metals and plastic.

In expressing the foregoing views, the examiner has made reference to statements made by a panel of the Board of Patent Appeals and Interferences in a prior decision on this case in which the examiner's rejection of an earlier version of claim 10 as being unpatentable over Bulla was sustained.[1] The present claim 10 contains the additional limitations that (1) the plastic and metal are "uniformly blended," (2) the metal filler is "all powder prior to being uniformly blended with the plastic," and (3) the finished putter has a "minimum hardness" of Shore A85.

The appellant has presented several arguments in opposition to the examiner's conclusion of obviousness, none of which we find to be persuasive, for the reasons explained below.

Bulla discloses a set of golf clubs, including a putter, in which the club heads are made of a moldable plastic and a metal filler that can be "filaments, fillings, or of powder form" (column 1, lines 63 to 67; column 4, line 18; emphasis added). This being the case, the appellant's argument that one of ordinary skill in the art would not have been taught by Bulla to use a powdered metal material is incorrect. Further in this regard, while Bulla states that a "suitable" plastic composition for club heads would

[1]No. 2001-1400, mailed September 26, 2001.

comprise unwoven continuous metal filaments, contrary to the theme conveyed in the appellant's arguments (Brief, page 7), Bulla does not suggest that powdered metal is unsuitable for use. Since all disclosures of the prior art, including unpreferred embodiments, must be considered in determining obviousness,[2] as we did in the earlier decision, we agree with the examiner that the artisan also would have been taught by Bulla to utilize powdered metal as well.

Further with regard to the metal powder, contrary to the discussion presented by the appellant on pages 7-9 of the Brief, it is our view that Bulla does not teach that a putter should not use all powder, for there is no basis for concluding that whatever form is selected for the metal filler - whether filaments or powder - all of the metal is not in the selected form, that is, all filaments or all powder. Thus, in the absence of evidence to the contrary, we agree with the examiner that one of ordinary skill in the art would have been taught by Bulla to utilize a single form of metal filler, that is, "all powder," as required by claim 10. We reach the same conclusion, based upon the same reasoning, with regard to the limitations that the metal be all powder "prior to" being blended and that it be "uniformly" blended with the plastic, for there simply is nothing in the reference that would instruct the artisan to do otherwise.

With regard to the requirement that the metal powder be between 50 and 95 per cent by weight of the composition, we stand by the position we set forth in the prior

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[2] In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979).

decision. Since a putter is a specialized club which is not used to drive the ball, it would have been clear to one of ordinary skill in the art that Bulla's disclosure concerning the application of a shock wave to the ball to provide maximum striking force (column 1, lines 50-56) would not be a consideration in the design of a putter. Nor do we believe one of ordinary skill in the art would regard Bulla's disclosure concerning the relationship of the amount of metal filler to the slope of the club face as being applicable to a putter, for the putter is not included in Bulla's discussion of face angles, but is presented as a separate item. What Bulla does teach with regard to the putter is that it should have a "feel" (i.e., a weight of swing) corresponding to that of the other clubs (column 3, lines 45-49), which in our view would have taught one of ordinary skill in the art to provide for the putter a weight of powder in the mixture that falls within Bulla's disclosed range of 25-75 percent, disregarding, because it is a putter, the proviso that the weight of metal be increased as the angle of the slope of the club face increases. We find no basis in the Bulla disclosure for the appellant's argument that the reference teaches that the putter must have a weight of swing that matches the rest of the clubs (Brief, page 10), and that the weight of metal in the filler should be determined by measuring the shaft length of the other clubs (Brief, page 11), in view of the fact that Bulla treats the putter separately (column 3, lines 45-49).

With regard to the declaration filed by the appellant (Paper No. 17), we repeat the position we took in the prior decision, which is that the evidence does not compare

the claimed invention to the closest prior art, that is, the Bulla putter, and therefore it does not establish that the claimed 50-95% range of metal filler achieves unexpected results relative to Bulla.

While we have carefully considered all of the arguments put forth by the appellant in the Brief and the Reply Brief, they have not convinced us that Bulla fails to establish a prima facie case of obviousness with regard to the subject matter recited in claim 10. This being the case, we shall sustain the standing rejection of claim 10. Furthermore, inasmuch as the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of dependent claims 12, 22-24, 26, 30 and 31, they are grouped with independent claim 10, from which they depend, and fall therewith. See 37 CFR § 1.192(c)(7) and Section 1206 of the Manual of Patent Examining Procedure.

CONCLUSION

The rejection is sustained.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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